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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRY KARANIKAS

Appeal 2009-000523
Application 10/661,445
Technology Center 3600

Decided: January 25, 2010

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
STEVEN D.A. MCCARTHY, and MICHAEL W. O'NEILL, *Administrative
Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Terry Karanikas (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 15-21. Appellant canceled claims 1-14. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

The Invention

The invention is directed to constructing a wall unit having layered discrete veneer components, such as stones, on the outer surface. Spec. 1:4-7.

Wall units with stone veneers are usually formed by first building a form. The veneer stones are placed within the form. Concrete is then poured over the stones and fills any gaps between the stones. The concrete is poured to a depth that covers the stones completely. The concrete is allowed to set. The resulting wall unit is removed from the form and set into position. *See* Spec. 1:9-13 (citing to US 1,856,906, issued on May 3, 1932, to Richard Carvel).

The process described in Carvel only permits a stone veneer on a single surface. If the construction design requires a stone veneer on more than one surface, e.g. two opposing sides, then two of these wall units would have to be separately constructed and positioned back-to-back. This would require more than one pour and increase the costs of the construction design. Spec. 1:14 to 2:4.

Accordingly, Appellant discloses as the invention a molding process that produces a wall unit with stone veneers on multiple sides and is completed with a single pour of concrete. Spec. 2:12-15.

The claimed invention is to a combination of a wall unit form and the formed wall.

Claim 15, reproduced below, is representative of the subject matter on appeal.

15. A combination of a wall unit form and a wall formed inside therein, the combination comprising:

a first surface, formed by an interior surface of a first wall panel;

a second surface operatively attached to said first surface, said second surface formed by an interior surface of a second wall panel;

end surfaces operatively attached to said first and second surfaces thereby forming an upright form and opposing sides, said end surfaces formed by interior surfaces of end wall panels;

wherein at least one of said first, second and end surfaces horizontally supports a plurality of irregularly-shaped discrete veneer components stacked vertically from the ground surface up against at least one panel, wherein the wall is formed during a single pour application of a binding material to the wall unit form; and

further wherein at least one of said first, second and end panels is configured to be removably attached from one another to facilitate entry into a volume defined by the upright form, wherein said entry allows for placement of said plurality of irregularly-shaped discrete components.

The Prior Art

The Examiner relies upon the following as evidence of unpatentability:

Carvel '504 (Carvel)	US 1,809,504	Jun. 9, 1931
Torricelli	US 3,116,570	Jan. 7, 1964
Schultz	US 5,511,761	Apr. 30, 1996
Sugiyama	US 5,836,572	Nov. 17, 1998
Dial, Jr. (Dial)	US 6,032,424	Mar. 7, 2000

*The Rejections*¹

The following Examiner's rejections are before us for review:

Claims 15-21 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 15-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15, 19, and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable given Dial and Sugiyama.

Claims 15 and 18-20 are rejected under 35 U.S.C. § 103(a) as unpatentable given Carvel and Sugiyama.

Claims 19 and 21 are rejected under 35 U.S.C. § 103(a) as unpatentable given Dial or Carvel, Sugiyama, and Schultz.

Claims 16 and 17 are rejected under 35 U.S.C. § 103(a) as unpatentable given Dial or Carvel, Sugiyama, and Torricelli.

¹ The Examiner withdrew the obviousness rejections based on Dial or Carvel and Torricelli. Ans. 2-3. We will address the contentions directed against Dial and Carvel *infra* notwithstanding that these rejections are withdrawn because Appellant relies on said contentions within the sections of the Appeal Brief referenced as "Issue 3" and "Issue 4" to urge for the patentability of the claims rejected based on Dial or Carvel and Sugiyama.

Contentions

35 U.S.C § 112, first paragraph, rejection

Appellant contends that the claimed limitations of “irregularly-shaped discreet veneer components” and “curvilinear edges” are supported in Figure 9 showing irregularly shaped pieces. App. Br. 7-8. Appellant contends that the claimed subject matter of “horizontally supports,” as called for in claim 15, is “inherently supported and necessarily present by Figures 1 and 9 and the totality of the teaching of the specification regarding stacking of the veneer components against the panel.” App. Br. 8.

35 U.S.C. § 112, second paragraph, rejection

Appellant contends that a person having skill in the art “has ample guidance after reading the plain meaning of the claim [language ‘horizontally supports’] in light of the enclosed Figure 1” to understand that the “surfaces of the wall unit form provides horizontally supports for the stacked veneer components and stop them from tipping over before the wall unit form is filled with binding material.” App. Br. 10. Appellant further contends a person of ordinary skill in the art would understand, after reviewing the drawings and the Specification, that the term curvilinear refers to objects bounded by curved lines and thus is definite. *Id.*

35 U.S.C. § 103(a) rejections based on Dial and Sugiyama

Appellant contends that Dial teaches away from Appellant’s invention of “stacking of irregularly-shaped veneer components” as claimed because Dial “teaches the insertion of rectangular bricks into holes within the face of the mold” and does “NOT teach using ‘*irregularly-shaped veneer components stacked from the ground up.*’” App. Br. 11. Appellant further contends that Dial “does not teach a panel that is ‘*configured to be*

removably attached from one another to facilitate entry into a volume defined by the upright form, wherein said entry allow for placement of said plurality of irregularly-shaped discrete components.’” App. Br. 12.

Appellant acknowledges that Dial may allow removal of the form, but that removal is not for placing irregularly-shaped discrete components within the panel because “no stacking occurs.” *Id.* Appellant acknowledges that Dial teaches positioning veneer rectangular bricks within the pockets in the face of the mold. However, the Appellant contends that Dial “does NOT teach being opened for placement by stacking because the bricks are placed in the pockets 62, prior to mold assembly because of the SMALL size of the wall unit that is then stacked in a fashion similar to a brick to form a wall.” *Id.*

Appellant contends that Sugiyama teaches away from Appellant’s invention and “does NOT teach a wall having ‘*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel*’ because Sugiyama’s irregularly-shaped veneer components are glued with adhesive into the receiving recess. App. Br. 17. To support the contention that Sugiyama fails to teach the claim language *supra*, the Appellant further contends that based on Sugiyama’s disclosure of the stone recesses being molded integrally within the foamed plastic substrate; this permits reasoning that “no veneer components [are] present BEFORE the addition of binding material to form the wall.” *Id.* Further, Appellant contends that Sugiyama’s “veneer components could not be stacked against the wall unit form as taught because the presence of projections to form the receiving recesses 22 would interfere [and] the wall unit form would NOT be taught to be reattached after the irregularly-shaped veneer

components are glued into the receiving recesses 22 forming the claimed invention.” App. Br. 17-18.

35 U.S.C. § 103(a) rejections based on Carvel and Sugiyama

Appellant acknowledges that Carvel teaches “forming a wall unit producing a wall with ‘irregularly-shaped veneer components.’” App. Br. 13. Appellant contends that the formation of the wall unit occurs “ONLY when the wall is produced laying face down on the ground ... vertically supported by the ground (wall face down).” App. Br. 13. Appellant contends that Carvel “does NOT teach using the applicant’s claimed ‘*first wall panel*’ or ‘*second wall panel*’ as required because it is formed against the ground and the panels are not required and therefore not present.” App. Br. 14. Appellant contends that because the irregularly-shaped veneer as taught in Carvel is produced by laying the veneer against the ground, applying the binding material, allowing it to set, and then physically propping the veneer into position, the wall produced “may not be as structurally sound or stable as the applicant’s claimed wall because it is not vertically stable before binding material is added and can more easily collapse if the binding material is deficient ... [and] may require use of heavy lifting equipment.” *Id.*

Appellant contends that a difference between a wall unit formed by Carvel and the claimed invention is that the claimed invention can have an irregularly-shaped veneer on at least two sides whereas Carvel allows an irregularly-shaped veneer on only one side. *Id.* Appellant acknowledges that Carvel does teach an embodiment that uses regular rectangular bricks stacked upon each other from the ground up, but Appellant contends that “one skilled in the art would only be motivated to look toward the solution

provided in the first embodiment when building a wall having an ‘irregularly-shaped veneer’ and would NOT be motivated to combine the two separate embodiments of wall unit forms having walls formed inside without further guidance.” App. Br. 15. Appellant contends while in one embodiment in Carvel the veneer bricks are stacked vertically and then the form is placed around to allow the binding material to be poured into the wall unit form, this embodiment is “NOT placed against (leaned against) at least one panel as is required with independent claim 15.” *Id.* The Appellant contends that Carvel’s vertically formed wall requires the veneer rectangular bricks to be vertically supported by spacers in order for the binder to adhere to the veneer. *Id.*

For the rejection based on Carvel and Sugiyama, the Appellant further contends that the Examiner “selectively chooses that the ‘572 patent teaches the use of irregular-shaped veneer components and then ignores all of the other teachings.” App. Br. 19-20. Appellant contends that the combination of Carvel and Sugiyama does not render obvious the claimed subject matter because Sugiyama “does not teach the irregular veneer structures as claimed by Applicant.” App. Br. 20.

SUMMARY OF DECISION

We AFFIRM.

OPINION

Issues

In light of the Appellant's contentions, the issues before us are as follows:

- (1) Has Appellant shown the Examiner erred in finding that the claimed subject matter of "irregularly shaped discreet veneer components," "curvilinear edges," and "horizontally supports" lacks an adequate written description within the originally filed disclosure?
- (2) Has Appellant shown the Examiner erred in finding that the claimed subject matter of "curvilinear edges" and "horizontally supports," is indefinite?
- (3) Has Appellant shown that the Examiner erred in concluding that the claimed subject matter would be rendered obvious when the teachings of Dial or Carvel with Sugiyama are combined?

Pertinent Facts

1. Appellant's Figure 9 is reproduced below.

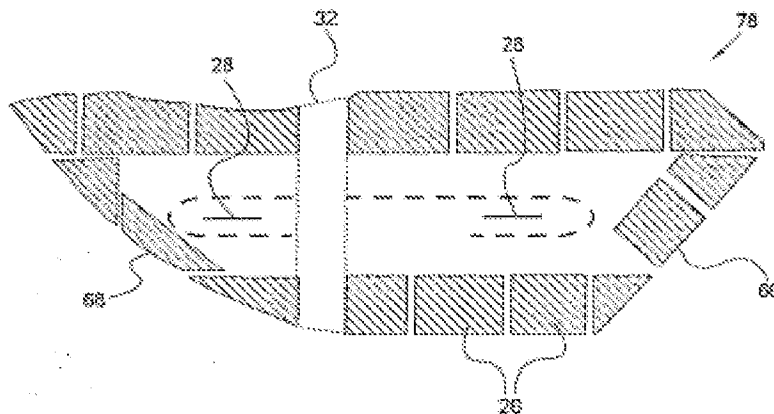


FIG. 9

Appellant's Figure 9 depicts a wall unit having irregularly-shaped veneer components and curvilinear edges.

2. Dial discloses a construction block and a mold form. As shown in Figures 15 and 16, Dial discloses an embodiment of its mold form (shown overall in Figures 6 and 8) that has recesses 62 in the interior surface 60 for receiving regularly-shaped veneer, e.g. bricks 64. Dial, col. 8, ll. 10-15.
3. Dial discloses that the veneer is placed within the mold. Dial, col. 8, l. 25.
4. Dial discloses that the mold form, shown in Figures 6 and 8, is formed of two separate side walls 17 and 17a that have posts 29. C-clamps 28 attached to the posts 29 serve to hold the side walls together during the pour of the binding material, e.g., concrete. Dial, col. 5, ll. 22-28.
5. Sugiyama discloses applying irregularly-shaped veneer components, artificial stones 10, into irregularly-shaped recesses 22 in an upright form, e.g., gate post shown in Figure 2. Sugiyama, col. 4, ll. 7-60.
6. Sugiyama discloses that adhesive mortar 23 is applied either to the veneer stones 10 or the receiving recesses 22. Sugiyama, col. 4, ll. 66-67.
7. Sugiyama discloses that protruding ribs 21 conform to the respective shapes of the stone veneer 10. Sugiyama, col. 4, ll. 28-30.
8. Carvel discloses a frame for forming a concrete wall corner section having the external appearance of a masonry or brick wall. Carvel, p. 1, ll. 1-10, p. 3, ll. 58-62 and figs. 26-33.

Principles of Law

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact. *Regents of Univ. of Cal. v. Eli Lilly and Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089 (1998) (citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)). To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that “the inventor invented the claimed invention.” *Id.* (citing *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (1997) and *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989) (“[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”)). Thus, an applicant complies with the written description requirement “by describing the invention, with all its claimed limitations, not that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Id.* (citing *Lockwood*, 107 F.3d at 1572). It is important to note that “[t]he invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed.*” *Vas-Cath*, 935 F.2d at 1564. Further, “[i]n deciding the issue [of written description], the specification as a whole must be considered.” *In re Wright*, 866 F.2d 422, 425 (Fed. Cir. 1989).

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). The second paragraph of 35 U.S.C. § 112 requires claims to set

out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). A prima facie conclusion of obviousness may be supported by a showing that the claims are directed to a process, machine, manufacture, or composition of matter already known in the prior art that is altered by the mere substitution of one element for another known in the field, and such modification yields a predictable result. *See id.* (citing *United States v. Adams*, 383 U.S. 39, 40 (1966)). The Court further stated that, “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR*, 550 U.S. at 417. When considering obviousness of a combination of known elements, the operative question is thus “whether the improvement is more than the predictable use of prior-art elements according to their established functions.” *Id.*

“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.” *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983).

Rigid application of a “teaching, suggestion, motivation” test for nonobviousness is incompatible with Supreme Court precedent. *KSR Int’l*, 550 U.S. at 419. The Examiner thus need not establish the existence of a teaching, suggestion, and motivation in combining teachings from prior art references; rather, the Examiner must provide an articulated reasoning with some rational underpinning to support a legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The analysis need not seek out precise teachings directed to the specific subject matter of the claim but can take into account the inferences and the creative steps that a person of ordinary skill in the art would employ. *KSR Int’l*, 550 U.S. at 418.

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See Ex parte Yamaguchi*, 88 USPQ2d 1606, 1614 (BPAI 2008) (on appeal, applicant must show examiner erred); *Ex parte Fu*, 89 USPQ2d 1115, 1123 (BPAI 2008); *Ex parte Catan*, 83 USPQ2d 1569, 1577 (BPAI 2007); and *Ex parte Smith*, 83 USPQ2d 1509, 1519 (BPAI 2007).

Analysis

Issue (1)

Appellant has shown that the Examiner erred in finding that the claim limitations of “irregularly-shaped discreet veneer components” and “curvilinear edges” lack an adequate description within the originally filed Specification. “[T]he written description requirement is satisfied by the patentee’s disclosure of ‘such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.’” *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002) (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir.

1997)). In this case, the Appellant has descriptive means such as Figure 9 (Fact 1) that fully set forth irregularly-shaped veneer components and curvilinear edges on a surface of the wall form unit such that the originally filed Specification would convey with reasonable clarity to those skilled in the art that, as of the filing date sought, Appellant was in possession of the invention as now claimed concerning these two claim limitations. *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991).

Appellant's arguments demonstrate that the Examiner erred in finding the claimed subject matter of a wall unit form panel horizontally supporting the veneer of the wall unit formed during a single pour application of the binding material was not adequately described within the originally filed Specification. The purpose of the written description requirement is to convey with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). The Appellant's position that a person having ordinary skill in the art would understand that the term "horizontally supports" means that the wall unit form panel prevents the veneer from tipping over is reasonable in light of the descriptive means of Figures 1 and 9.

Issue (2)

Appellant's arguments demonstrate that the Examiner erred in finding the claimed subject matter indefinite. The definiteness of claim language must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). The curvilinear aspect of

the wall form unit and wall form itself is reasonably shown in Figure 9 as the Specification would be interpreted by a person possessing the ordinary level of skill in this art. As Appellant argues, just as the veneer components are vertically supported by the ground and each underlying veneer component previously stacked, the interior surfaces of the wall unit form provide the horizontal support for the stacked veneer and, as such, stop the veneer components from tipping over before binding material is poured.

Issue (3)

Appellant has not shown the Examiner erred in concluding that the claimed subject matter is rendered obvious by the combined teachings of either Dial or Carvel with Sugiyama. While Dial does not teach the utilization of an irregularly-shaped veneer as Appellant contends, the Examiner acknowledged this omission in Dial. Instead, Dial discloses utilizing a regularly-shaped veneer in the mold form (Fact 2) and, as such, the Examiner utilized Sugiyama's teaching of an irregularly-shaped veneer (Fact 5). The Examiner found that a person of ordinary skill in the art could readily provide the mold form of Dial with an irregularly-shaped veneer in conjunction with or as a substitute for the regularly-shaped veneer disclosed in Dial based on the teachings of Sugiyama in order to provide "a natural look to the wall surface." Ans. 6-7.

Dial provides the wall form that receives the regularly-shaped veneer (Fact 2) and Sugiyama provides the teaching for receiving an irregularly-shaped veneer into recesses of a mold form (Fact 5). A person having ordinary skill in the art based on these teachings could readily substitute an irregularly-shaped veneer and provide recesses therefor, or provide a regularly-shaped veneer in conjunction with an irregularly-shaped veneer

into the wall unit form disclosed in Dial. Such a technique for improvement of Dial's mold form does not appear to be beyond the skill level of a person of ordinary skill in the art. Moreover, the Appellant has not provided evidence that the improvement of combining a wall unit form and wall unit with an irregularly-shaped veneer yields something more than the predictable result of a wall unit having an irregularly-shaped veneer on the visible surfaces.

Appellant's argument that Dial does not have a panel that is configured to be removably attached from another panel to facilitate entry into a volume defined by the form created by the panels, and wherein the entry allows for placement of a veneer, is unconvincing to demonstrate that the Examiner erred. Dial's two separate side walls (panels) are secured together by clamps attached to the posts of each side wall (panel) and a veneer is placed on the interior surface of the mold form. (Fact 4.) The panels are separate prior to being secured with the clamps. As such, a person having ordinary skill in the art would consider that the panels are configured to be removably attached from each other.

Dial discloses that interior surface 60 of the outside mold wall 66 has recesses 62 that receive veneer components 64 and that the veneer 64 is placed within the mold. (Facts 2 and 3.) A person of ordinary skill in the art would understand that prior to clamping the side walls together, in order to place the veneer inside the mold form, at least an artisan's hand would have to place the veneer components on the interior surface of the mold. Thus, the side walls of Dial facilitate an entry into the interior volume in order to place the veneer components within the recesses of the mold. As such, Dial's disclosure would render obvious having a panel that is configured to

be removably attached from another panel to facilitate entry into a volume defined by the form created by the panels and the entry allows placement of a veneer.

Concerning the placement of an irregularly-shaped veneer into the volume, the Examiner utilized Sugiyama to teach using an irregularly-shaped veneer. Nothing unpredictable occurs by having an artisan's hand inserting irregularly-shaped veneer components inside Dial's volume when the recesses were modified to accept an irregularly-shaped veneer as the Examiner found. Thus, the combined teachings of Dial and Sugiyama render obvious the claimed subject matter of a panel that is configured to be removably attached from another panel to facilitate entry into a volume defined by the form created by the panels, and wherein the entry allows for placement of an irregularly-shaped veneer.

Appellant's argument that Sugiyama teaches away from the Appellant's invention is unconvincing.

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.

In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). *See also KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416-417 (2007) (explaining that when the prior art teaches away from a combination, that combination is more likely to be nonobvious).

Appellant contends that Sugiyama teaches away because Sugiyama teaches that the veneer is glued into the recess, no veneer is present before the addition of binding material, and its projections to form the recesses would interfere. These teachings neither lead in a direction divergent from the Appellant's path, discourage a person having ordinary skill in the art from following the path taken by Appellant, nor suggest a line of development that is unlikely to be productive. Sugiyama teaches applying irregularly-shaped veneer components into irregularly-shaped recesses in an upright form. (Fact 5.) Sugiyama uses an adhesive mortar. (Fact 6.) Adhesive mortar is a binding material. Claim 15 just requires a single pour application of a binding material. Sugiyama teaches that the binding material is either applied to the veneer or the recess. (Fact 6.) Thus, binding material does not have to be present before application of the veneer, but can be applied with the veneer. The projections (ribs) are in conformity with the veneer. (Fact 7.) Thus, the projections do not interfere with the application of the veneer as Appellant's contention suggests. As such, Sugiyama's teachings appear to follow the path taken by Appellant with respect to placing irregularly-shaped veneer components into a mold form capable of receiving such a veneer.

Appellant's contentions against Carvel are unconvincing to demonstrate that the Examiner erred. The contentions focus on an embodiment not utilized by the Examiner to conclude that the claimed subject matter is obvious. The Examiner did not utilize Carvel's mold form that produces the veneer on the ground as shown in Figures 1-4. The

Examiner utilized Carvel's mold form taught in Figures 26-33.² As such, the Appellant's contentions do not address the Examiner's findings.

Appellant's contention directed to Carvel's veneer wall would not be as strong as Appellant's veneer wall is speculative and not commensurate with the claims on appeal. Nothing in the claim is directed to the strength of the wall unit. Appellant's contention that the difference between Carvel and the claimed invention is that the claimed invention can have an irregularly-shaped veneer on at least two sides as compared to Carvel one-sided veneer is not commensurate with the scope of the claim. Claim 15 only requires one side to have a veneer.

Appellant's contention that a person of ordinary skill in the art would only look to Carvel's first embodiment and would not combine the two separate embodiments within Carvel does not address the findings of the Examiner. The Examiner applied the teachings of Carvel's second embodiment and the irregularly-shaped veneer teachings within Sugiyama. Appellant's contention that the difference between Carvel and the claims is that Carvel's veneer is not leaned against the panel as claimed is not commensurate with the scope of claim 15. Claim 15 does not limit the veneer to leaning against a panel. Claim 15 just requires the veneer to be stacked vertically from the ground surface up against a panel. Stacking the veneer vertically against a panel does not require the veneer to lean against the panel, i.e., the panel can be considered a plumb line that the veneer is touching in order to make sure the veneer is vertical.

² Here, Carvel discloses a frame for forming a concrete wall corner section having the external appearance of a masonry or brick wall. (Fact 8.)

Appellant's contention that Carvel requires spacers for support does not show error in the Examiner's rejection because the claims are open-ended and as such does not exclude additional, unrecited elements such as spacers. *See Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.) Appellant's argument that the Examiner is improperly picking and choosing some teachings of the references while not using others overlooks well-settled precedent. "[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR Int'l.*, 550 U.S. at 420. Moreover, in obviousness determinations, all of the features of the secondary reference need not be bodily incorporated into the primary reference. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Appellant's contention that Carvel and Sugiyama fail to render obvious the claimed subject matter because Sugiyama does not teach the irregularly-shaped veneer structures as claimed attacks Sugiyama individually rather than attacking what the combined teachings of Carvel and Sugiyama would render obvious to a person having ordinary skill in the art. Again, the relevant inquiry is whether the claimed subject matter would have been obvious to those of ordinary skill in the art in light of the *combined teachings* of those references. *See In re Keller*, 642 F.2d at 425. Further, "[c]ombining the *teachings* of references does not involve an ability to combine their specific structures." *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973). Additionally, the contention is not commensurate with the scope of claim 15. Claim 15 just requires irregularly-shaped veneer

components. Nothing limits the shape other than that the shape is irregular. Sugiyama teaches an irregularly-shaped veneer. (Fact 5.)

In view of the foregoing, we sustain the Examiner's rejections of claim 15 given Dial or Carvel and Sugiyama. Appellant does not separately argue claims 19 and 20 with respect to the rejection given Dial and Sugiyama nor separately argue claims 18-20 given Carvel and Sugiyama. As such, claims 18-20 fall with claim 15 for the same reasons.

Appellant's contention against the rejection of claims 19 and 21 given Dial or Carvel, Sugiyama, and Schultz (App. Br. 21-22), and the rejection of claims 16 and 17 given Dial or Carvel, Sugiyama, and Torricelli (App. Br. 23-24) essentially rely on the same arguments against the rejection of claim 15, simply pointing out what the claims recite and not specifically pointing out supposed errors in the Examiner's position. For the reasons given above, Appellant's contentions that repeat the claim language associated with claim 15 are unconvincing as to show error in the Examiner's position concerning the rejections of the dependent claims 16, 17, 19, and 21. Further, statements that merely point out what a claim recites will not be considered an argument for separate patentability of the claim. Thus, Appellant's contentions are unconvincing in demonstrating that the Examiner erred in rejecting claims 16, 17, 19, and 21 with the given prior art used in these rejections.

CONCLUSIONS

Appellant has shown the Examiner erred in finding that the claimed subject matter of "irregularly shaped discreet veneer components," "curvilinear edges," and "horizontally supports" lacks an adequate written

description within the originally filed disclosure, and erred in finding that the claimed subject matter of “curvilinear edges” and “horizontally supports,” is indefinite.

Appellant has not shown that the Examiner erred in concluding that the claimed subject matter would be rendered obvious when the teachings of Dial or Carvel are combined with Sugiyama.

DECISION

The Examiner’s decision to reject the claims under 35 U.S.C. § 112, first and second paragraphs, is reversed.

The Examiner’s decision to reject the claims under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

mls

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